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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/339,605	06/24/1999	DAVID L. PATTON	79296F-P	2805

1333 7590 02/27/2002

PATENT LEGAL STAFF  
EASTMAN KODAK COMPANY  
343 STATE STREET  
ROCHESTER, NY 14650-2201

EXAMINER
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WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/339,605

Applicant(s)  
Patton et al

Examiner  
Mark Wallerson

Art Unit  
2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-20 is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 21-25 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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**Part III DETAILED ACTION**

**Notice to Applicant(s)**

1. This application has been examined. Claims 1-25 are pending.

***Information Disclosure Statement***

2. The references listed in the Information Disclosure Statement dated 6/24/99 have been considered by the Examiner and is attached to this Office Action.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 6, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "and/or" in the claims is indefinite.

5. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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***Claim Objections***

6. Claims 5 and 6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claim 5 and 6 are in preceding claims 2 and 3 respectively. Maybe Applicant meant that these claims should depend on claim 4.

7. Claim 24 is objected to because of the following informalities: In line 6 of the claim, "and" should be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 1, 2, 3, 4, 5, 6, 7, 11, 12, 13, 14, 15, 21, 22, 23, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Nelson et. al. (hereinafter referred to as Nelson) (U. S. 6,132,024).

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With respect to claims 1, 2, 4, 5, 7, 15, 21, 22, 23, and 24, Nelson discloses a method for making a digital print comprising the steps of obtaining a digital image file for printing by a printer (receiving text or images) (column 2, lines 3-6); printing on to media using a digital printer on the image (column 3, lines 20-25), and printing a coordinate system (positional-calibration indicia) that is not visible to the human eye separate from the printing of the image (column 4, lines 21-31), the coordinate system being capable of locating a specific area on the print (column 2, lines 22-28).

With respect to claims 3, 6, Nelson discloses that the coordinate system is printed over the image (column 4, lines 21-24).

With regard to claims 11, 13 Nelson discloses an inkjet printer (column 6, lines 7-11).

With respect to claims 12 and 14 Nelson discloses a printer comprising a first mechanism for printing a visible image on the media (column 3, lines 20-25) and a second mechanism for printing a coordinate system (positional-calibration indicia) that is not visible to the human eye (column 3, lines 26-30).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8, 9, 10, 16, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Hakamatsuka et al. (hereinafter referred to as Hakamatsuka) (U. S. 5,410,642).

With respect to claim 8, Nelson differs from claim 8 in that he does not clearly disclose additional data which is not visible to the human eye under normal viewing conditions printed on the same side as the image.

Hakamatsuka discloses printing attribute information (16) which is not visible to the human eye under normal viewing conditions (in infrared ink) along with other information (column 7, lines 14-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nelson wherein additional data which is not visible to the human eye under normal viewing conditions would be printed on the same side as the image. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nelson by the teaching of Hakamatsuka in order to increase the amount of information that the user may place on the document.

With respect to claims 9 and 10, Nelson discloses that the print is made on paper (column 1, lines 40-45).

With regard to claims 16 and 17, Nelson differs from claims 16 and 17 in that he does not clearly disclose that the coordinate system is provided in a specific pattern which corresponds to a different type media. Hakamatsuka discloses using different patterns for each lot (column 4, lines 26-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

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invention to have modified Nelson wherein the coordinate system is provided in a specific pattern which corresponds to a different type media. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nelson by the teaching of Hakamatsuka in order to improve the image processing system.

*Allowable Subject Matter*

12. Claims 18-20 are allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Application/Control Number: 09/339,605

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Arlington, VA.

Sixth Floor (Receptionist)

  
**MARK WALLERSON**  
**PATENT EXAMINER**

MARK WALLERSON